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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,740	02/14/2002	Eugene Jarvis	3079.010	3485
51500	7590	11/25/2005	EXAMINER	
PATZIK, FRANK & SAMOTNY LTD. 150 SOUTH WACKER DRIVE SUITE 900 CHICAGO, IL 60606			BROCKETTI, JULIE K	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/077,740

Applicant(s)

JARVIS ET AL.

Examiner

Julie K. Brockett

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6,8,10,11,13,14,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,8,10,11,13,14,17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3, 5, 6, 8, 10, 11, 13, 14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carrico et al., U.S. Patent No. 6,416,407 B1 in view of by Yoseloff, U.S. Patent No. 6,227,969 B1.** Carrico et al. discloses a method for playing a draw poker game on a video draw poker gaming machine, including initially dealt cards, an opportunity for the player to hold at least one of said initially dealt cards and a final hand composition created by replacing selected cards from the initial hand of cards. The gaming machine is a computing device and includes a microprocessor in communication with the screen display. A selection device is in communication with the microprocessor for providing means by which the player interacts with the computing device. A power supply is in electrical communication with the screen display. The microprocessor allows the game to perform the following steps (See Carrico col. 8 lines 24-65). A first wager is placed on whether a final hand composition will match one of a plurality of

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preselected combination of cards that are ranked in a particular order (See Carrico col. 4 lines 19-22). A hand of initially dealt cards is dealt to a player and displayed on the screen display (See Carrico Fig. 2; col. 4 lines 30-32). A card determining means is in communication with the computing device for randomly determining in succession the composition of the initial hand of cards and for randomly determining the final hand of cards (See Carrico col. 4 lines 30-55). It is then determined by the game and the player whether the initially dealt cards match one of the plurality of pre-selected combination of cards and a ranking is determined for the initially dealt cards. The player selects none, one or more held cards from said hand of dealt cards (See Carrico col. 5 lines 13-16). A second bet is offered after the initially dealt cards are dealt and prior to replacing each card not held, that the final hand composition will match a particular one of the plurality of pre-selected combination of cards, unless all initially dealt cards are held. For example, a first wager is placed, initial cards are dealt (first hand), the player can then hold or replace the cards (second hand), then the player is offered the second wagering opportunity. If the player places the second wager, they can once again hold and replace the cards forming a third and final hand. Consequently, the player is offered the second bet after the initial cards are dealt but prior to replacing each card not held in the second hand. The particular one of the plurality of the pre-selected combination of cards is ranked higher than the ranking of the initially dealt cards (See Carrico col. 5 lines 1-59). One additional card is dealt

to the player to replace each card not held in order to provide a final hand composition. (See Carrico col. 5 lines 17-22). It is then determined if the final hand matches one of the plurality of preselected combination of cards as to the first wager (See col. 5 lines 23-26). A card determining means is in communication with the computing device for determining in succession the composition of the initial hand of cards and for randomly determining the composition of the final hand of cards. The card determining means determines the composition of the final hand of cards and deals the cards needed to complete the hand so as to provide a payout to the player based on the composition of the final hand of cards (See Carrico col. 4 lines 33-67; col. 5) [claims 1, 6, 11, 13, 14]. The poker game is 5-card draw poker (See Carrico col. 2 lines 55-59) [claims 3, 8]. At a certain stage of the game, i.e. after an initial deal of cards and discards, the player is offered an additional wagering opportunity based on a possible final hand composition, only if the player decides not to hold all the initially dealt cards and it is not impossible to improve the poker hand ranking of the initially dealt cards [claims 1, 6]. The player must make a second wager for this opportunity. The held cards are automatically held upon acceptance of the second wager [claims 5, 10]. The plurality of pre-selected combination of cards comprises: Royal Flush, Straight Flush, Full House, Three of a Kind, Two Pair and One Pair (See Carrico col. 6 lines 30-60) [claim 17]. The machine automatically determines the player cards to hold when the player places the wager (See Carrico col. 5 lines 47-59)

[claim 18]. Carrico lacks in disclosing this second betting opportunity as a proposition bet in which the outcome of the bet is determined separately from the initial wager and is placed after the initial hand of cards are dealt.

Yoseloff teaches of placing proposition bets in the game of poker after the initial hand of cards are dealt (See Yoseloff col. 4 lines 57-67; col. 6 lines 13-33) [claims 1, 6, 11, 13, 14]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method of placing proposition bets in the game of poker after the initial cards are dealt in the invention of Carrico. By placing an additional bet as in the game of Carrico after the cards have been dealt but before the draw, a player can make an educated wager since they know what cards they already have and what cards they would need to draw in order to have a winning outcome. Furthermore, players enjoy the opportunity to win more than one wager, by using the propositional betting system of Yoseloff in the invention of Carrico, players could still win their initial wager as well as their second wager instead of merely adding the second wager to the first in which case if a winning outcome does not occur with regards to the second wager, the player automatically loses his first wager too. Consequently, by using the method of Yoseloff, players have more enjoyment in the game since they have two chances of winning instead of just one. Furthermore, players would be more inclined to place an additional wager if they knew that they were not automatically forfeiting their first wager.

While the Examiner Carrico and Yoseloff teach all of the claimed limitations, the Examiner further notes that with respect to claims 13 and 14 it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation, *Ex parte Masham*, 2 USPQ2d 1647 (1987). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, in the structural claims dictated by claims 13 and 14 are capable of being used in a different manner that would not result in a structural difference, only a difference of a software program executed by the respective processors. Hence the recitation that the device be employed in a specific manner regarding the actions of the structure does not differentiate the claimed apparatus from the Carrico apparatus, which satisfies the claimed structural limitation. Additionally, the Applicant is invited to review MPEP §2114 R-1 which states: Apparatus and Article Claims – Functional Language. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the

structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Additionally, the MPEP §2114 R-1 clarifies that an apparatus claim is drawn to the structure of the device, not the function, by stating “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

### ***Response to Amendment***

It has been noted that claims 1, 6, 13 and 14 have been amended.

### ***Response to Arguments***

Applicant's arguments filed September 23, 2005 have been fully considered but they are not persuasive.

Applicant argues that Carrico does not teach placing a proposition bet after the initial cards are dealt but prior to replacing the cards. The Examiner does agree with Applicant that the second wager is placed after the second hand of cards is formed. For example, the player places a first wager and is dealt an initial hand of cards. The player is then allowed to hold or replace the cards to form a second hand. After the second hand is formed, the player is then given the opportunity to place a second wager. If the player places the wager, they are then allowed to hold and replace cards to form a third and final card hand. Consequently, Carrico does teach of placing an additional bet after



the initial cards are dealt but prior to replacing the cards (i.e. replacing the cards from the second hand to form a third hand). The Examiner notes that Applicant's claims are open ended by using the term "comprising". Therefore, the fact that Carrico discloses an additional step of allowing the player to replace cards from the initial hand to form a second hand, does not mean that the reference does not read on Applicant's claim language. The Examiner further notes that the cards replaced to form the third and final card hand can be cards that were initially dealt to the player. For example, the player could replace only 1 card to form the second hand and then replace the 4 initial cards after the secondary wager to form the third card hand. Therefore, in this situation, the initial cards are replaced after the second wager has been placed.

Applicant further argues that Carrico's secondary wager is not a proposition bet and that Carrico teaches against placing proposition bets by requiring the player to give up any potential winnings of the second hand upon placing a second bet. While the Examiner does agree that Carrico does require the player to give up any potential winnings of the second hand upon placing a second bet, this does not teach away from having the secondary bet be a proposition bet. Proposition bets are well known in the art and can be made after the initial deal of cards as seen from Yoseloff. Therefore, one would be motivated to combine the concept of a proposition bet placed after an initial deal of cards with Carrico so that players have an additional chance to win a bet and win more prizes. As clearly seen from Yoseloff, it is obvious for one of

ordinary skill in the art to implement proposition bets. Proposition bets have been well known throughout the art for many years and it is obvious to place them after the cards are dealt so that the player can make an educated wager for the bet based on the cards they already have. This is common knowledge in the art, in that the player would want to have as many facts concerning the possible outcomes prior to placing a bet.

Applicant argues that the Examiner relies on the common knowledge that the player “wants every advantage in the game” which is contrary to the principal that the games are designed to give the house the advantage and therefore, they would not make games that give players the advantage. The Examiner notes that the industry is concerned with creating games that are exciting and entertaining to players. By allowing players to make multiple wagers in a game and therefore allowing them to win multiple bets, the player’s enjoyment of the game increases. Consequently, it is obvious to create games that players would be more inclined to play because they are exciting or give players the opportunity for multiple wins as in the case of proposition bets.

The Examiner points out that Yoseloff is used solely to illustrate that proposition bets are well known in the art and that they can be made after the cards have been dealt and prior to a final hand of cards. Carrico is being used to show all of the other limitations.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be

recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

With regards to claims 13 and 14, the Examiner notes that since these are apparatus claims, the claims must differ from the prior art in terms of structure and not function. Therefore, Applicant must argue the structural differences between Applicant's invention, Carrico and Yoseloff and not rely on differences in terms of functional language.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In

no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K. Brockett whose telephone number is 571-272-4432. The examiner can normally be reached on M-Th 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Julie K Brockett  
Primary Examiner  
Art Unit 3713